

REMARKS

In response to the final Office Action mailed 22 October 2003, the application has been carefully reviewed. Applicant thanks Examiner Uhler for his analysis of the cited references and detailed Office Action, contributing to advancing prosecution of the application. Applicant respectfully requests reconsideration of the application.

Rejections under 35 U.S.C. §103

Claims 5-20, 23-24, 26, 33-39, 42-43, 56, 58-61, and 63-65

Claims 5-20, 23-24, 26, 33-39, 42-43, 56, 58-61, and 63-65 stand rejected under 35 U.S.C. §103 as being obvious over Junker (U.S. Patent No. 4,994,311) in view of Ford (U.S. Patent No. 5,545,448). [Paper 18, Page 2, Paragraph 3]

A colliquefiable power coating is not an intended use limitation

The Examiner asserts, “The limitation ‘colliquefiable power coating’ is an intended use limitations and do not appear to be further limiting in so far as the structure of the product is concerned.” [Paper 18, Page 2].

Applicant respectfully submits the term “colliquefiable powder coating” is not an intended use, but rather specifically limits the structure of the powder coating. That is, the limitation requires a powder coating which is colliquefiable. This is a distinguishing characteristic of a powder coating, rather than an intended use. For example, there are numerous powder coatings, which are not colliquefiable¹. Gunpowder and sawdust are powders, but are not colliquefiable. In fact, the primary reference Junker discloses a non-colliquefiable powder coating. Junker provides a sintering process to produce very small dots of sintered material. Even if Junker is construed to disclose a powder coating as set forth by the Examiner, it does not disclose a colliquefiable powder coating.

¹ While applicant has maintained that a “powder coating” as described in the present application means a colliquefiable powder coating, the term “colliquefiable” has been added to more particularly claim the invention. Thus, the recitation of “powder coating” in the Remarks is in accordance with the position of the Examiner.

An intended use of a powder coating would be “to induce sneezing” or “to form a tracer for fingerprints.” In contrast, a “colliquefiable powder coating” is a specific material that is readily distinguishable from all other powders, in that it is colliquefiable.

The reliance upon *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458 (CCPA 1963) does not support the construction of the claim language asserted by the Examiner.

In *In re Casey*, the claims were directed to an apparatus, wherein the claim limitations were present (or obvious) in view of the prior art (Kienzle), although the product of the cited reference was used for different purpose. The court characterized the difference as, "It seems apparent, therefore, that the position taken by the appellant does not involve any unobvious difference between the structure of his apparatus and that of Kienzle, but relates solely to the matter of use of the devices." *In re Casey*, 238. Accordingly, the court stated, "the manner or method in which such machines is to be utilized is not germane to the issue of patentability of the machine itself." *In re Casey*, 238.

In contrast, the present claims do recite a method or manner of using any powder. Rather, the present claims recite a specific powder, a colliquefiable powder. The sintered powder of Junker forms dots of sintered material and is not colliquefiable powder. The Junker powder is a different powder than is recited in the present claim. The present limitation of "a colliquefiable powder coating" is not an intended use of the powder, but rather distinguishes and limits the type of powders that can be employed. The Junker powder is just not a colliquefiable powder.

Similarly, *In re Otto* fails to address the present claim limitations. In *In re Otto*, the court stated, "It seems appellants are endeavoring to predicate patentability upon a certain procedure for curling here using this device and involving a number of steps in the process. This process is irrelevant as is the recitation involving hair being wound around the core in so far as the determination whether these particular claims should be allowed or rejected." *In re Otto*, page 459. In contrast, the present claims are not an example of a different use of the same powder, but rather a different powder.

The primary reference does not disclose a colliquesfiable powder coating, but rather a sintered dot forming powder.

Applicant respectfully submits the present limitation is similar to that discussed by the Court of Appeals for the Federal Circuit in *Orthokinetics Inc. v. Safety Travel Chairs Inc.* (1 USPQ2d 1081 (Fed. Cir. 1986). In *Orthokinetics*, a relevant limitation was "wherein said front leg portion is so dimensioned as to be insertable through the space between the door frame of an automobile and one of the seats thereof." *Orthokinetics*, page 1088. The court responded that "the claims were intended to cover the use of the invention with various types of automobiles. That a particular chair in which the claims read a date within some automobiles and not others is of no moment. The phrase 'so dimensioned' is as accurate as a subject matter permits, automobiles being of various sizes." Applicant submits the present "colliquesfiable powder coating" is even more of a structural limitation than the "so dimensioned" limitation approved by the Federal Circuit in *Orthokinetics*.

Therefore, applicant respectfully submits the term "colliquesfiable powder coating" is not an intended use limitation, but rather properly limits the particular powder coating.

Dots, over some or all of a surface, are not a colliquesfied powder coating

The Examiner further asserts that "although Junker teaches that when the powder is melted it forms "dots" on the surface of the strip [see column 3, lines 38-41] It is the examiners position that the powder coating taught by Junker is capable of forming a colliquesfied powder coating, as it is specifically taught to be formed over 'some or all' of the exposed external surface of the gripping part [column 2, lines 33-34]. Thus, if the powder is disbursed over 'all' the external surface, it reads on the limitations of claim 5." [Paper 18, Pages 3-4].

Applicant respectfully submits a critical portion of this quotation is omitted. Specifically, "the gripping part" is omitted. That is, the gripping part of Junker is either plastic or rubber, not part plastic and part rubber. Thus, though the Junker powder may

be on some or all of the gripping part, it is not on both the gripping part and the sponge rubber sealing portion.

In addition, there is no basis for the allegation by the Examiner that "the powder coating taught by Junker is capable of forming a colliquesfied powder coating, as it is specifically taught to be formed over "some or all" of the exposed external surface of the gripping part" [Paper 18, Page 3, Paragraph 6]. That is, the powder coating of Junker is specifically selected to form sintered dots. Whether these dots appear over portions or the entire weatherseal, these dots are not colliquesfiable.

The cited references just do not disclose the recited limitation of a colliquesfiable powder coating.

Therefore, the powder coating of Junker cannot read on the recited colliquesfiable powder coating of Claim 5.

Selectively picking and choosing from the references is impermissible

The Examiner states "Junker does not teach applying the powder coating to both the first polymeric portion and the second polymeric portion of the weatherseal, as required by claim 5." [Paper 18, page 4]. To cure this deficiency, the Examiner relies upon Ford "solely for the teaching of the esthetic benefit gained by coating both the seal and trim portions of a weather seal with a colored coating." [Paper 18, Paper 4].

"It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). *See also Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600." *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It is impermissible to pick and choose from selected portions of a reference. The reference must be considered as a whole. There are numerous statements in Ford which highlight the danger of the selected picking and choosing from Ford.

Specifically, “there is now a desire to make edge trims, seals and combination seals incorporating edge trims entirely of elastomeric material.” [Ford, Col. 1; lines 29-31]. “A composite door seal and edge trim is shown comprised of a dynamic bulbous seal portion 1 extruded in one from an elastomeric material such as EPDM in known manner, with a static edge trim or carrier portion 3.” [Ford, Col. 2, lines 19-23].

“1. A polymeric strip, usually of EPDM rubber (and formed a dense and/or sponge rubber, which may or may not be reinforced with a carrier) is extruded in known manner.” [Col. 4, lines 29-33].

Thus, the express teaching of Ford of applying specific chemistry to a single material is not accommodated in the outstanding rejection.

Further, Ford expressly employs an aromatic, solvent based spray coating which is blended in an exact proportion to allow precise reaction stoichiometry to the cross linking component. In fact, Ford expressly recites the ratio of the individual polyisocyanates to each other as critical in affording a polyurethane coating material with the correct proportions of adhesion, flexibility and light fastness. (Col. 3, lines 21-30).

In view of this express precision solvent based chemistry, the Examiner asserts it would be obvious to dispose an entirely different powder coating (colliquefiable v. sintered dots) in an entirely different coating system (powder coating) over a different combination of materials than contemplated by the primary reference.

While the Examiner “does not purport that it would be obvious to substitute the specific colored coating of Ford for that of the powder coating taught by Junker” [Paper 18, Page 4, Paragraph 11], applicant respectfully submits the entire reference must be considered as a whole and, as such, does not support the asserted rejection.

That a reference does not exclude a modification does not render the modification obvious

With respect to the issue of Junker coating only the gripping portion, not the seal portion, Examiner notes that “the reference [Junker] contains no language that indicates that the powder coating could not be applied to other portions of the weather seal.” [Paper 18, Pages 4-5]

Under 35 USC §103, it is insufficient for a reference to preclude the asserted modification. Rather, the reference must show the suggestion.

“Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *Id.* at 1073 “The opinion then lists each step and states where in the cited prior art references the step can be found. This reference-by-reference, limitation-by-limitation analysis wholly fails to demonstrate how the prior art teaches or suggests the combination claimed in the ’411 patent.” *Ecolochem v. Southern California Edison Co.* 56 USPQ2d 1065, 1075 (Fed. Cir. 2000).

“Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. [citations omitted] *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

“Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” [citations omitted] *Ecolochem v. Southern California Edison Co.* 56 USPQ2d 1065, 1073 (Fed. Cir. 2000).

The Federal Circuit has stated the “implicit generalized finding by a district court that when one of ordinary skill was faced with a problem [of the patent] in view of a prior art reference, that the combination claimed would have been obvious is insufficient.” *Ecolochem* at 1075.

“A rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed.” *Ecolochem* at 1076.

“In *In re Dembiczak*, we noted that:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Therefore, the assertion that the prior art does not preclude a claim limitation cannot sustain the burden of showing a motivation.

The Examiner further asserts, “Therefore it would have been obvious ... to coat both the trim and sealing portion of the automotive weather seal of Junker with the decorative powder coating. One would have been motivated to make this modification for aesthetic reasons, such as to match the weather seal with the paintwork and interior of an automobile, as described in Ford et al.” [Paper 18, Page 4, Paragraphs 9-10]

This assertion fails to address the specific teaching of Junker to form small dots of the sintered material. That is, to applied the Junker sintered dots over both the trim and sealing portion of Junker would produce any modeled or discolored appearance, rather than a unified appearance.

With respect to Claim 6, the Examiner “interprets the plastic materials, to include thermoplastics and thermosetting materials.” [Paper 18, Page 5, Paragraph 12] Applicant respectfully submits this interpretation is at best strained by Junker. Specifically, Junker recites separate “plastics or rubber material.” [Col. 1, line 53]. Were the interpretation of

the Examiner to be employed, Junker would disclose thermoplastics, thermosetting materials and rubber. It is difficult to find support for the assertion that rubber is not a thermosetting material.

The Examiner further asserts it would have been obvious as "Junker as modified by Ford teaches coating the sealing surface with a powder coating to form a decorative surface." [Paper 18, Page 7, Paragraph 19] However, coating the sealing surface to form a merely decorative surface could obviate the purpose of having the sealing surface. That is, the problem in the art has been providing attractive seals, wherein the seals provide the desired sealing function.

In addition, the Examiner has failed to account for the proposed modification removing the express purpose of Ford to employ precise chemistry in an aromatic solvent based spray coating.

With respect to Claim 19, the Examiner asserts, "Although Junker does not specifically teach this limitation [glass appearance of colliquescence], it is the examiners position that the powder coating of Junker will be glossy 'to some degree.' Thus, the limitations of this claim are met as set forth above for claim 10." [Paper 18, Page 7, Paragraph 20]

Bare assertions by the Examiner are insufficient to sustain a rejection. There must be some objective evidence. "Deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Lee*, 1434-1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). "Common knowledge and common sense, even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority." *In re Lee*, 1435. "The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale in which it relies." *In re Lee*, 1435. Therefore, the rejection of Claim 19 is legally insufficient.

In view of these deficiencies, applicant respectfully submits Claims 5-20, 23-24, 26, 33-39, 42-43, 56, 58-61, and 63-65 are in condition for allowance.

Claims 1-4, 40-41, 44, 46-50, and 52-55

Claims 1-4, 40-41, 44, 46-50, and 52-55 stand rejected under 35 USC §103 as being unpatentable over Katoh (US 4,291,076) in further view of Junker and Ford.

With respect to the rejections, the Examiner asserts Katoh teaches an automotive weather seal comprising a metal sheet 2, a body 1, and layers 3a3, 3b3, lips 3c3 (figure 4B and column 3, lines 50-65). [Paper 18, Page 10, Paragraph 39]. The metal layer 2 is considered by the Examiner to be equivalent to the claimed metal reinforcing layer. The body 1, layers 3a3, 3b3, and lips 3c3 are made of polymer materials and are considered by the Examiner to be equivalent to applicant's claimed resilient polymeric body. [Paper 18, Paragraph 39]

The Examiner recognizes Katoh fails to disclose a heat fusible powder coating directly on the surface of the metal reinforcing member and directly on a portion of the resilient polymeric body. [Paper 18, Paragraph 40]

The Examiner asserts it would have been obvious to coat the entire weatherseal taught by Katoh including the body 1, metal 2, coatings 1a3, 1b3, 1c3, 3a3, 3b3, and lips 3c3.

This is directly contrary to Katoh.

Applicant respectfully disagrees with the Examiner's equivalence of the metal layer 2 of Katoh to applicant's claimed metal reinforcing layer.

As set forth in Katoh, the metal layer 2 "is a stainless steel foil or an aluminum foil having at least one anodized surface and the thickness of the metal layer . . . is in the range of 30-200 microns and, in the case of a window trim, 100-120 microns is preferable." [Column 2, lines 55-60]. In contrast, the remaining protective layers of Katoh may have a thickness of 0.5 to 2 millimeters. Thus, the polymeric substrate is from approximately 10 to almost 100 times thicker than the foil layer. The equivalence of the Katoh foil to the claimed metal reinforcing layer is further weakened by Katoh's statement that "the protective layers 3a and 3b enable the trim molding strip to properly

fit and contact the vehicle body and/or window. . . the protective layer compensates for irregularities in the dimensions of the vehicle and acts as an insulator between the metal foil of the trim molding strips and the metal surface of the vehicle body, thereby preventing galvanic corrosion.” [Column 4, lines 45-57].

The Examiner relies upon Junker and Ford to cure the failure of Katoh to teach a heat fusible powder coating directly on the surface of a metal reinforcing member and directly on a portion of the resilient polymeric body. The Examiner relies upon the secondary references to assert it would be obvious to utilize the powder coating taught by Junker to coat the entire weatherseal taught by Katoh including the body 1, the metal 2, and the coatings. The motivation to coat the entire weatherseal of Katoh in light of the teaching of Ford is that both the gripping and sealing portions of the weatherseal are preferably coated with the color coating to match the trim of the vehicle. [Paper 18]

This is absolutely contrary to the express purpose of Katoh. Katoh is directed to a trim molding strip having a synthetic resin body and a metal foil. The entire purpose of Katoh is to provide an exposed metal surface.

To cover the Katoh metal would preclude it from its express intended purpose, and this cannot sustain a rejection under 35 USC §103. Further, as the remaining portions of Katoh are not visible, there would be no incentive to coat these portions.


The Examiner further asserts “the exposed portion of the metal 2 is equivalent to the applicant’s claimed trim portion and the 3b3 and lips 3c3 of Katoh to be equivalent to the applicant’s claimed sealing portion.” {Paper 18, Pages 12-13, Paragraph 46]

Thus, the Examiner has equated the exposed foil of Katoh on both a trim portion and a reinforcing layer.

As the proposed modifications are expressly contrary to the cited references and would preclude the primary reference from achieving its intended purpose, the asserted rejections of Claims 1-4, 40-41, 44, 46-50, and 52-55 cannot be sustained.

Therefore, applicant respectfully submits all the pending claims, Claims 1-20, 23, 24, 26, 33-44, 46-50, 52-56, 58-61, and 63-65 are in condition for allowance and such action is earnestly solicited. If, however, the Examiner feels any further issues remain, he is cordially invited to contact the undersigned so that such matters may be promptly resolved.

Respectfully submitted,



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